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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,154	01/12/2007	Takayoshi Kawamura	450106-05231	9464

7590 04/28/2009
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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04/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,154	Applicant(s) KAWAMURA ET AL.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/9/05 & 1/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communications: the application and Preliminary Amendment filed 12/09/2005.

Claims 9-12 are currently pending. Claims 1-8 have been cancelled. Claims 9 -12 are independent Claims.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # Japan 2003-166312 filed in Japan on 06/11/2003, which papers have been placed of record in the file.

Oath/Declaration

3. The Office acknowledges receipt of a properly signed Oath/Declaration submitted 01/12/2007.

Information Disclosure Statement

4. The Applicant's Information Disclosure Statement, filed 12/09/2005 and 01/12/2007, has been received, entered into the record, and considered. See attached form PTO 1449.

Drawings

5. The drawings filed 12/09/2005 are accepted by the examiner.

Specification

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The title of the invention is objected to because it does not comply with MPEP § 606.01.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Applicant is reminded of the proper language and format for an abstract of the disclosure. See MPEP § 608.01(b).

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds the limit of 150 words. Correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “*can be*” (Claim 9, Line 13; Claim 10, Line 12; Claim 11, Line 13; and Claim 12, Line 13) renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The use of similar exemplary language “*for example*” or “*such as*” was found to be indefinite in the following cases: Ex parte Hall, 83 USPQ 38 (Bd. App. 1949); Ex parte Hasche, 86 USPQ 481 (Bd. App. 1949); Ex parte Steigerwald, 131 USPQ 74 (Bd. APP. 1961).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 12 is software per se. The claim fails to assert the program stored on a computer-readable storage medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Since a

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computer program is merely a set of instructions capable of being executed by a computer without a computer-readable storage medium needed to realize the computer program's functionality, it is regarded as nonstatutory functional descriptive material.

Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by **Koyama** (US 6112010, issued 08/29/2000).

As to Claim 9:

Koyama teaches an information process apparatus that processes a plurality of pieces of data recorded on a record medium [See Col. 1, line 56 – Col. 2, line 27 → *the picture recording apparatus according to this invention electrically handles still pictures as picture data ... reading pictures (pictorial images) recorded on photographs or books, etc., video tape recorder equipment for reproducing still pictures recorded on a video tape to input them, optical disc reproducing (playback)*

equipment for reproducing still pictures recorded on an optical disc], comprising the steps of:

- identification means for identifying encoding systems for the plurality of pieces of data in an edit for which they are connected and successively reproduced [*See Col. 6, lines 17 – 65 → management file for carrying out management of correspondence information between respective files in the plurality of picture files, and management information for carrying out, in predetermined recording units of the recording medium, relative position on the recording medium between the management file and the picture file... a data management structure to designate a desired picture file from the plural picture files having different resolutions on the basis of management data of the management file to designate position on the recording medium within the picture file designated by the management file on the basis of the management data of the management information... since management information for designating picture file are all recorded within the management file, even in the case where correspondence state (situation) between picture files and the display order of pictures are changed by editing operation; See also, Col. 22, line 60 - Col. 26, line 5 and Col. 66, lines 45 – Col. 68, line 36];*
- generation means for generating one management information file that manages the result of the edit so that the management information file contains a group name to which all the encoding systems identified at the identification step belong and recording the management information file in a directory of the record

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medium attachable and detachable to and from the information process apparatus, the directory for the management information file being different from other directories of the record medium [See Col. 36, line 62-Col.37, line 7, lines 1-19

→ *Respective picture data recorded on the optical disc 20 are, as shown in FIG. 23, such that directory D1 (PIC_MD) is provided as directory for recording picture data so that file management is carried out therewithin. In addition, plural files are caused to further undergo management by subdirectories...there are provided, within the directory D1, overall information management file f1 (OV_INF. PMF) for carrying out management of the entire information, overall index file f2 ((OV_INF. PMX) for carrying out management of the entire index file, and respective picture directories D2 to D4 (PIC00000 to PIC00002) of respective albums. Moreover, there are provided, within the directory (PIC_MD) print directory (PRINT) for carrying out management of print information such as tint (hue) of print, print size, and rotation, etc., Telop directory (TEROP. PMS) for carrying out management of Telop such as title, etc. picture subjected to monitor display, key word retrieval directory (KW_DTBS. PMO) attached to picture numbers of respective pictures or the respective pictures, time stamp directory (TS_DTBS. PMO) for carrying out management of recording date, etc. of picture, and reproduction (playback) control directory (PMSEQ) for carrying out management of a program reproduction such that only designated picture is reproduced; See also, the Col. 45, line 56 - Col. 46, line 48];*

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- determining means for reading the management information file generated at the generation step and recorded on the record medium and determining whether all the plurality of pieces of data can be reproduced according to the group name contained in the management information file when the plurality of pieces of data are reproduced as the result of the edit [See Col. 63, lines 34-64 → *At the step S125, the system controller 6 controls the disc recording/reproducing section 5c so as to read out all management files (overall information management file, picture data management files of respective directories, print control data management file, reproduction control management file) through the storage section controller 5d, and temporarily stores, into the RAM 6a, the all management files which have been read out... it is necessary to display what picture data are recorded in respective directories to cause the user to designate desired picture. For this reason, at the step S128, the system controller 6 controls the disc recording/reproducing section 5c so as to display overall index file recorded on the optical disc 20. Thus, the processing operation proceeds to step S129. The overall index file is a file in which index picture data which are the same as an arbitrary one index picture of index picture data stored in the picture index files below (at the lower level of) respective picture directories are registered in display order of monitor. By monitor-displaying the overall index file, the user can carry out designation of desired index picture; see Col. 68, lines 1-7 → At the step S160, the system controller 6 controls the disc recording/reproducing section 5C so as to read out data U_ TOC, overall*

information management file and picture data management file in the RAM 6a to write them onto the disc to thereby update the respective data. Thus, the entire routine according to the editing operation of picture is completed; see also, Figs. 38 and 46].

As to Claim 10:

Refer to the discussion of claim 9 above. Claim 10 is the same as Claim 9, except Claim 10 is an information process method Claim and Claim 9 is an information apparatus Claim.

As to Claim 11:

Refer to the discussion of claim 9 above. Claim 11 is the same as Claim 9, except Claim 11 is a record medium Claim and Claim 9 is an information apparatus Claim.

As to Claim 12:

Refer to the discussion of Claim 9 above for rejection. Claim 12 is the same as Claim 9, except Claim 12 is a program Claim and Claim 9 is an apparatus Claim.

Conclusion

10. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review

each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00 am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Maikhanh Nguyen/
Examiner, Art Unit 2176

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176